

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
Keith Oliver et al.) Group Art Unit: 2632
Serial No. 10/038,421) Examiner: Previl, Daniel
Filed: January 7, 2002)
For: HEAT SOURCE LOCATOR)

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APPEAL BRIEF

I. INTRODUCTION

This is an appeal from the decision of the Patent Examiner, Group Art Unit 2632, finally rejecting claims 1-6 and 9-17 in the subject application.

II. REAL PARTY IN INTEREST

The Applicant is the real party in interest.

III. RELATED APPEALS AND INTERFERENCES

None.

IV. STATUS OF THE CLAIMS

Claims 1-6 and 9-17 stand rejected by the final action mailed March 23, 2004. Claims 1-6 and 9-17 are pending. Applicant hereby appeals the final rejection of claims 1-6 and 9-17.

V. STATUS OF AMENDMENTS

None.

VI. SUMMARY OF INVENTION

Applicant has invented a heat source locator to be used in combination with a light viewing device enabling one to view a light outside the visible spectrum of a human, the heat source locator comprising thermal detection means for detecting a thermal change within a field of view, the thermal detection means having a central axis within the field of view and an indicator which indicates the sensing of a heat source; and light emitting means for generating light, the light emitting means having light beam of a wavelength outside the visible spectrum of a human, the light beam being aligned generally parallel and closely adjacent to the thermal detection means axis. With this construction, an operator may locate a heat source by sensing the presence of the heat source through the thermal detection means and then locating the position of the located heat source by directing the light beam from the light emitting means while viewing the location with a light viewing device.

VII. ISSUES

The issues in the Appeal are whether Claims 1-6 and 9-17 are unpatentable under 35 USC §103 as being obvious by Lezotte in view of Morris et al.

IX. GROUPING OF CLAIMS

Claims 1-5 stand and fall together as they all contain the limitation of the thermal detection means and light emitting means.

Claims 6 and 9-12 stand and fall together as they all contain the limitation of the heat source locator having a

housing, a thermal detector and a light emitting device. The housing is included in this set of claims.

Claims 13-17 stand and fall together as they all contain a thermal detector, a light emitting device and a light viewing device. Claims 13-17 differ from claim 1-12 as these claims include the additional limitation of the light viewing device.

IX. ARGUMENT

Applicant's claim 1 defines a heat source locator to be used in combination with a light viewing device enabling one to view a light outside the visible spectrum of a human is disclosed. The heat source locator comprises thermal detection means for detecting a thermal change within a field of view. The thermal detection means has an axis generally centralized within the field of view, and an indicator which indicates the sensing of a heat source. The heat source locator also has light emitting means for generating light having a wavelength outside the visible spectrum of a human. The light beam is aligned generally parallel and closely adjacent to the thermal detection means axis. With this construction, an operator may locate a heat source by sensing the presence of the heat source through the thermal detection means and then locate the position of the located heat source by directing the invisible light beam from the light emitting means while viewing the location with a light viewing device. As the light being generated is invisible the heat source does not realize that a locator beam is being directed to it.

Applicant respectfully submits that the patentable element in the present application is the fact that the light produced by the locator is emitted at a wavelength which is invisible to humans. As the examiner correctly pointed out the light emitted by the LeZotte patent is visible light. Also, the examiner has taken the position that the light emitted from the Morris patent

discloses light emitting means having a lightbeam of a wavelength outside the visible spectrum of a human. Applicant respectfully submits that it is improper to combine the teachings of LeZotte with that of Morris as such a combination would destroy the intended use of both inventions. The LeZotte patent discloses a flashlight which must use visible light, otherwise it is not a flashlight. To effectively remove the light means from LeZotte and replace it with the infrared light source of Morris would destroy the intended use of the LeZotte reference as it would no longer operate as a flashlight. Similarly, if the night vision device of Morris were to replace the infrared light source shown in the patent with a visible light source shown in the LeZotte patent the intended purpose of the Morris device would again be destroyed. The Morris night vision device specifically utilizes an infrared light source to avoid detection, the addition of the visible light source of LeZotte would greatly reduce this objective. Furthermore, this combination would only produce a night vision device with a visible light addition, this would not produce a heat detecting device at all.

As such, Applicant respectfully submits that it is improper to combine the references sighted by the examiner to render Applicant's invention obvious. Furthermore, neither reference sighted by the examiner indicate, suggest or motivate one to depart from the clear teachings of the invention, much less the intended objective of the inventions, and combine the teachings as suggested by the examiner. Clearly, LeZotte is intended to utilize visible light to render the device a flashlight and Morris is intended to utilize invisible light to render it undetectably. These references and their intended purposes are diametrically opposed to each other.

Applicant also respectfully submits that the proposed combination of LeZotte with Morris does not produce the heat source locator recited in claim 1. Applicant's heat source locator includes light emitting means which generates an

invisible light beam generally parallel and closely adjacent the central axis of the thermal detection means. Both the flashlight of LeZotte and the night vision device of Morris produce a light beam that effectively washes a large area and is therefore not a beam which is generally parallel and closely adjacent the central axis. It should be noted that a flashlight does not produce a small concentrated beam but instead produces a large area of illumination so that the visible light reveals a subject. Also, the light in Morris is produced to aid the illumination of the entire field of view of the night vision device and therefore produces a beam which washes over the entire area. Conversely, Applicant's device produces a concentrated beam to pinpoint a direction along the centerline of the thermal detection means, i.e., a "light beam ..aligned generally parallel and closely adjacent to said thermal detection means axis" as shown clearly in Fig. 2 wherein the thermal field of view FV is shown diverging outwardly along the axis LA while the infrared laser beam IRB is shown as a non-diverging straight line. As such, the combination of LeZotte and Morris would produce a device that includes a visible or invisible beam that washes an entire area for illumination purposes, as oppose to the pinpointing of the centerline as claimed by Applicant. Therefore, the combination of these references does not make obvious Applicant's claimed invention.

It is well settled that the obviousness of an invention cannot be established by combining the teaching of the prior art absent some teaching, suggestion or incentive supporting the combination, see *In reFine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Ashland Oil, inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *ACSHospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cit 1984); *Pentec, Inc. v Graphic Controls Corp.*, 776 F.2d 309, 227 USPQ 766 (Fed.Cir. 1985). Moreover, the mere fact that the prior art could be modified in the manner suggested by the

examiner does not make such a modification obvious unless the prior art fairly suggests the desirability of the modification, see *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the references do not suggest any motivation for, or the desirability of, Applicant's unique construction of the thermal detector in conjunction with an invisible light source. As such, it is improper to utilize these references to establish obviousness.

It is acknowledged that the tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. MPEP 2142. This is "especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'" *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) citing *WL Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). With this in mind, a hindsight-based obviousness analysis must be supported by evidence which is "clear and particular". *In re Denbjczak*. It is insufficient to simply offer a broad range of sources or to make conclusory statements, as "[broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'". *Id.*

Applicant respectfully submits that the examiner has claimed the present invention to be obvious utilizing hindsight, speculation and conclusory statements which are not, in fact, supported by the cited references, to come up with a combination that would either destroy the clear intention of the reference or modify such in a manner that goes against the clear teachings of the reference. Furthermore, it is submitted that it is only

through such hindsight that the Applicant's invention can be gleaned from the cited references. Applicant respectfully contends that the invention is not obvious, but instead is novel and therefore worthy of patent protection.

Applicant submits that as independent claims 1, 6 and 13 all include the limitation of the invisible light source the just submitted argument applies equally to all such claims.

The requisite fee due upon filing of this brief is attached. Any additional fee is to be charged to Baker Donelson Bearman Caldwell & Berkowitz, PC, Deposit Account No. 11-0553.

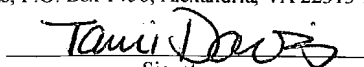
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APPENDIX A

APPLICANT'S CLAIMS

1. A heat source locator to be used in combination with a light viewing device enabling one to view a light outside the visible spectrum of a human, the heat source locator comprising:

thermal detection means for detecting a thermal change within a field of view, said thermal detection means having a central axis within said field of view and an indicator which indicates the sensing of a heat source; and

light emitting means for generating light, said light emitting means having light beam of a wavelength outside the visible spectrum of a human, said light beam being aligned generally parallel and closely adjacent to said thermal detection means axis;

whereby an operator locates a heat source by sensing the presence of the heat source through the thermal detection means and then locating the position of the located heat source by directing the light beam from the light emitting means while viewing the location with a light viewing device.

2. The heat source locator of claim 1 further comprising

a second light emitting means, said second light emitting means generating a beam of light in a visible spectrum and being aligned generally parallel and closely adjacent to said axis of said thermal detection means.

3. The heat source locator of claim 1 wherein said thermal detection means produces a visual indication of the sensing of a heat source.

4. The heat source locator of claim 1 wherein said thermal detection means produces an audible sound of the sensing of a heat source.

5. The heat source locator of claim 4 wherein said thermal detection means includes an earpiece speaker.

6. A heat source locator comprising;
a housing;
a thermal detector mounted within said housing to detect a heat source generally along a field of view; and
a light emitting device mounted within said housing positioned to emit a beam of light having a wavelength outside the visible spectrum of a human and generally centered along said thermal detector field of view;

whereby an operator locates a heat source by sensing the presence of the heat source

through the thermal detector and then locating the position of the heat source by directing the light beam from the light emitting device while viewing such with a light viewing device adapted to view the emitted wavelength.

9. The heat source locator of claim 6 further comprising a second light emitting means; said second light emitting means generating a beam of light in a visible spectrum and being aligned generally parallel and closely adjacent to said thermal detection means linear direction of sensitivity.

10. The heat source locator of claim 6 wherein said thermal detection means produces a visual indication of the sensing of a heat source.

11. The heat source locator of claim 6 wherein said thermal detection means produces an audible sound of the sensing of a heat source.

12. The heat source locator of claim 11 wherein said thermal detection means -includes an earpiece speaker.

13. A heat source locator system comprising;
a thermal detector having a beam of sensitivity along a central axis;

a light emitting device positioned to produce a beam of light having a wavelength outside the visible spectrum of a human and aligned generally along said thermal detector beam of sensitivity central axis; and

a light viewing device adapted to enable a viewer to view the light produced by said light emitting device,

whereby an operator locates a heat source by sensing the presence of the heat source through the thermal detector and then locating the position of the heat source by directing the light beam from the light emitting device while viewing the location with the light viewing device.

14. The heat source locator of claim 13 further comprising a second light emitting means, said second light emitting means generating a beam of light in a visible spectrum and being aligned generally parallel and closely adjacent to said thermal detection means linear direction of sensitivity.

15. The heat source locator of claim 13 wherein said thermal detection means produces a visual indication of the sensing of a heat source.

16. The heat source locator of claim 13 wherein said thermal

detection means produces an audible sound of the sensing of a heat source.

17. The heat source locator of claim 16 wherein said thermal detection means includes an earpiece speaker.